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LESAVICH HIGH-TECH LAW GROUP, P.C. SUITE 325 39 S. LASALLE STREET CHICAGO, IL 60603			NGUYEN, TAN D	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/876,408
Filing Date: June 07, 2001
Appellant(s): BROWN, CHARLES P.

Stephen Lesavich
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/24/2007 appealing from the Office action mailed 5/18/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,272,469	KORITZINSKY ET AL	8-2001
6,470,321	CUMMINGS ET AL	10-2002
6,519,589	MANN ET AL.	2-2003

7,076,541 BURSTEIN ET AL. 7-2006

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. Claims 1-13, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, the 2nd step of “accepting a one-time permanent registration fee” is vague and indefinite. From the specification, it appears this phrase appears to mean “accepting a one-time permanent registration fee payment” and therefore, insertion of the term “payment” after “fee” is recommended to improve clarity.

Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of KORITZINSKY et al.**

Claim 1 is as followed:

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:
 - accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;
 - accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and
 - issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

Claim 1 reads over:

A method for protecting a subscription service with a permanent service certificate wherein the service is domain name registrations subscription, comprising:

accepting information associated with a subscription service, wherein the subscription service is domain name registration obtained from a public domain name registrar on a domain name registration system;

accepting a one-time permanent registration fee for the subscription service wherein the subscription service is domain name registration, on a permanent subscription service system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the subscription service; and

issuing a permanent service certificate based on the accepted information, wherein the subscription service is domain name registration, and the permanent service certificate is about domain name registration and the certificate provides a permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

As shown under the “Background of the Invention” in the specification, the domain name registration basically is subscription service that identifies and protect the IP addresses to make it easier for people to identify the sites on the Internet. Every year, each subscriber has to pay \$35.00/year for the maintaining of the service {see page 4, last paragraph}.

Similarly, as indicated in the specification, under "Background of the Invention", **AAPA** fairly discloses a method for domain name registrations service with a annual registration receipt (certificate), comprising:

- (a) accepting information associated with a domain name registration (subscription service) obtained from a public domain name registrar on a domain name registration system {see page 3, last two paragraphs};
- (b) accepting a yearly (annual) payment of registration fee for the domain name registration (subscription service) on the annual domain name registration system {see page 4, last paragraph}; and
- (b) issuing an annual registration certificate (receipt) for the domain name registration based on the accepted information {see pages 4-6, see "a domain name can registered electronically at nsi.com" on page 3, line 19-21}.

AAPA fairly teaches the claimed invention except for the type of fee payment for subscription (registration) service from annual payment (\$35.00/year) to a one-time permanent registration fee with would result in an issuing of a permanent registration certificate (receipt) in step (c.), for example a payment of \$3,500 to cover 100 years or \$1,000,000 for perpetually permanent service).

In another subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines 15-50}. In view of the general problems with respect to the expired subscribed

service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is “fee payment option” and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service.

As for the limitation of “wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration”, this reads over the limitation “lifetime or non-expiring warranty service” of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

As for the limitation of a certificate, this reads over the term “receipt of the service request” as shown in col. 21, line 24-26. As for the limitation “a permanent registration certificate”, this is taught in AAPA / KORITZINSKY et al when “life time” service is selected/requested and the receipt of the service requested would inherently include the “permanent service”.

5. As for dep. claim 2 (part of 1 above), which deals with well known computer readable medium having stored therein instructions for causing a processor to execute the steps of method claim 1, this is inherently included in the online system of AAPA /KORITZINSKY et al.

6. As for dep. claims 3, 9 (part of 1 above), which deals with well known information displaying parameters, i.e. certificate or receipt of fee payment for service, this is fairly taught in Fig. 1, Fig. 15, Fig. 8, "212", "PROBLEM DESCRIPTION".

7. As for dep. claims 12-13 (part of 1 above), which deals with well known payment parameters, i.e. electronically or manually, these are inherently included in the registration over the Internet as taught in AAPA. Alternatively, the manual payment of fee by mail or other would have been obvious because this is well known practice.

As for method claims 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which basically have the same limitations as in claims 1-3, 9, 12-13 above, they are rejected for the same reasons set forth above.

8. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al .

As for dep. claims 4-5 (part of 1 above), the teachings of AAPA /KORITZINSKY et al is cited above. MANN et al, as shown on col. 2, lines 4-18, is cited to disclose well known facts that many domain names have been registered by sellers/brokers as

assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names to point to their content sources.

CUMMINGS et al is cited to teach well known business practice of obtaining insurance policy and title for an equity /asset to cover financial losses associated with the equity, thus protecting the equity/asset investment in case of losses {see col. 1, lines 15-20, claim 1}. It would have been obvious to modify the teachings of AAPA /KORITZINSKY et al by obtaining insurance policy and title as taught by CUMMINGS et al for the domain name registration to protect the domain names since MANN et al discloses that domain names are valuable assets/equity that can be sold for large sums of money.

9. Claims 6-8, 10-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, 19-20 above, and further in view of BURSTEIN et al.

As for dep. claims 6-8, 10-11 (part of 1 above) and 21-22 (part of 19 above), the teachings of AAPA /KORITZINSKY et al is cited above. BURSTEIN et al is cited to teach well known facts that many domain names have been registered by sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names and many cases, the registrant may incorporate one or more domain names into an organization identity or business {see col. 2, lines 40-50}. As for dep. claims 6-8 and 10-11, which deal with well known business parameters for carrying out a business or corporation such as issuing shares, issuing leases or sub-leases of an asset, etc., and the practices of these business

parameters in the teachings of AAPA /KORITZINSKY et al would have been obvious as routine business parameters.

(10) Response to Argument

Applicant's arguments filed 2/13/2007 have been fully considered but they are not persuasive since they are merely applicant's opinions/allegations.

In response to applicant's argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is “fee payment option” and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so

cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al.

As for the limitation of “wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration”, this reads over the limitation “lifetime or non-expiring warranty service” of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

As for the request of the examiner to list the reason why the Examiner has violated MPEP rule 706.07 cited by the applicant on page 4 of the response of 2/13/07, there are two issues:

- (1) the examiner requested the applicant to cite where in the MPEP rule 706.07 with respect to the specific citation by the applicant ... “To bring the prosecution ...or a final rejection”, the examiner has a hard time finding this citation/argument, and
- (2) the examiner has made the 2nd non-final rejections of 8/25/06 for the reason stated above, see paragraphs no. 5-10.

As for the arguments with respect to....

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Conferees:

1) John Weiss, SPE 3629

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629

/Vincent Millin/

2) Vincent Millin, Appeals Practice Specialist TC 3600